

REMARKS

By the foregoing Amendment, Claims 1 and 14-16 are amended, and Claims 2 and 6 are cancelled. Entry of the Amendment, and favorable consideration thereof, is earnestly requested. Claims 7, 13 and 20-27 having been previously cancelled, and Claims 2 and 6 being cancelled herein, Claims 1, 3-5, 8-12, 14-19 and 28-32 are currently pending.

Claim Objection

Claim 16 was objected to as containing an informality. Claim 16 has been amended such that Applicant believes the objection has been obviated.

Rejections under 35 U.S.C § 112

Claims 10 and 12 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner has asserted that “[i]t is unclear what amounts of the claimed ingredients may, or may not, be present in the chewing gum tablet to be considered ‘substantially free’ of said ingredients.” Applicant respectfully traverses this rejection.

The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d

818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. See MPEP § 2173.05(b). Specifically, it has been recognized that the term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention, and that while it is a broad term, its use is generally acceptable. *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). For example, in a case similar to the present one, the Court held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).

In the present case, Applicant respectfully submits that one skilled in the art would know what is meant by the term "substantially free" (i.e., that the chewing gum contains no effective amount of the claimed ingredients, although a non-functional trace amount may be present). The Examiner has provided no rationale as to why one skilled in the art would not know what is meant by the term, and instead appears to be stating that the term "substantially" is essentially always indefinite, which of course, is contrary to case law and MPEP guidelines. There is no analysis as to why the term "substantially" is indefinite in this particular instance, as opposed to those cases where the Court has found its use perfectly acceptable. As such, Applicant respectfully asks that this rejection be withdrawn.

Claims 16 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention on the basis that it was unclear whether the claimed weight was referring to the weight of the entire chewing gum tablet or of the chewing gum center. Applicant believes that this rejection has been obviated by the above amendments to Claim 16.

Rejections under 35 U.S.C § 103 (a)

All Claims were rejected under 35 U.S.C. § 103(a) primarily over Cherukuri et al. (U.S. Patent No. 4,753,805) or Yang (EP 0 221 850). Applicant respectfully asks the Examiner to reconsider these rejections in view of the above Amendments and the below Remarks.

In the pending application, the need for obtaining compressed chewing gum tablets resembling conventional chewing gum with respect to texture has been addressed.

Relevance of prior art documents

Prior art documents Cherukuri et al. and Yang relating to tableted chewing gum have been cited, and Applicant acknowledges that such documents would be

consulted by a person of ordinary skill in the art seeking to prepare a tabletted chewing gum.

However, as regards the patent to Hinzpeter et al. (U.S. Patent No. 5,643,630), it should be noted that this is found within a different technical field, not related to chewing gum, but relating to tableting in general. Also, it should be noted that none of the classifications by search classes of Hinzpeter et al. are overlapping with those of Cherukuri et al. or Yang.

It can be argued, of course, that the teachings of tableting in general are relevant for tabletted chewing gum, but it should be kept in mind that the character of chewing gum base materials is very different from conventional tabletted materials and moreover that both conventional chewing gum and tableting in general have been known for many years without tabletted chewing gum on the market. In recent times, however, Applicant has succeeded in providing a compressed, i.e., tabletted, chewing gum with a texture resembling conventional chewing gum and brought it to the market.

Teaching by Cherukuri et al. and Yang

At the time of the invention, a person of ordinary skill in the art reading Cherukuri et al. and Yang would find in Cherukuri et al. the teaching that: "Conventional chewing gum compositions are difficult to form into chewing gum

tablets because of their moisture content.” [See, e.g., column 1, lines 16-18].

Thus, according to Cherukuri et al., when dealing with conventional chewing gum compositions, there are three possibilities when attempting to make tabletted chewing gum [column 1, lines 57-66 and column 2, lines 64-68]:

- either freezing the chewing gum composition,
- or changing the conventional formulations to have lower moisture contents,
- or blending of compression aid into the chewing gum composition.

In Cherukuri et al., the last option is presented as the invention:

It has surprisingly been found that a conventional chewing gum composition having a moisture content of about 2% to about 8% by weight can be granulated utilizing a grinding aid and subsequently blending the resultant granulation with a compression aid. [See, e.g., column 2, lines 59-63].

From Cherukuri et al., it would thus be apparent that a tabletted chewing gum comprising a conventional chewing gum composition can be prepared, and the person of ordinary skill in the art would not receive any further hints about reaching a tabletted chewing gum having a texture resembling conventional chewing gum.

Turning to Yang would not add further enlightenment as to how to obtain a texture in tabletted chewing gum resembling that of conventional chewing gum. Yang confirms the possibilities of freezing the chewing gum composition or altering

the composition and confirms the mixing with lubricants into the chewing gum composition [See, e.g., Yang, page 5, lines 34-37], but mainly Yang is concerned with employing a delivery system for active ingredients to thereby eliminate plasticization of the gum base. [See, e.g., Yang, page 2, lines 47-51].

The Obviousness Rejections - 35 U.S.C. 103(a)

The Examiner has acknowledged that both Cherukuri et al. and Yang are silent as to:

- (a) the gum center being encapsulated by the barrier layer
- (b) the improved and sticky texture of the tablet resulting from the inclusion of the natural resin.

In relation to (a), the Examiner stated that:

One of ordinary skill in the art at the time the invention was made wishing to improve the compressed tablet of Cherukuri et al. the process by which it was made by providing a barrier layer using less magnesium stearate or other lubricant, would have found it obvious to employ the tableting method of Hinzpeter et al. for tableting the chewing gum....

Applicant respectfully objects to the assumption that a person of ordinary skill in the art would have a wish to improve the compressed tablet by providing a barrier layer as he/she could not have a wish of improving by something that he/she did not know would be an improvement.

The idea of providing a barrier layer is, as recognized by the Examiner, not apparent from either of Cherukuri et al. or Yang, and it is respectfully submitted that in fact there is neither any teaching, suggestion, or motivation of a barrier layer in these documents. Therefore, a person of ordinary skill in the art would have to either: (i) provide this idea on his/her own, which Applicant respectfully submits would go beyond the level of ordinary skill in the art, or (ii) find a teaching of a barrier layer within the prior art. However, as the patent by Hinzpeter et al. does not mention chewing gum or any gum-like material for that matter, Applicant respectfully submits that there are a huge number of documents on this level of relevance and a person of ordinary skill in the art would not have any motivation to turn to this exact document.

Even if the skilled person should somehow be aware of Hinzpeter et al., he/she would refrain from applying this method as he/she would, based on his/her knowledge of chewing gum stickiness, not expect that the method would be applicable when dealing with chewing gum, and moreover because (i) either, the lubricant added according to Hinzpeter et al. would be additional to the already added amount according to Cherukuri et al. or Yang, and this would compromise the achievements in these inventions of keeping a certain moisture content, or (ii) the lubricant added according to Hinzpeter et al. would be taken from the amount of lubricant originally intended for addition into the chewing gum composition in accordance with Cherukuri et al. or Yang. This again would compromise the clear

teaching about blending the compression aid into the chewing gum composition in order to avoid it being necessary to either lower the moisture content or apply freezing of the chewing gum composition. [See, e.g., Cherukuri, column 1, lines 57-66, Yang, page 1, lines 14-16].

Moreover, a person of ordinary skill in the art consulting Hinzpeter et al. would recognize that the benefits of applying the method of Hinzpeter et al. would be a reduced amount of pressure in the compression step [See, e.g., Hinzpeter et al., column 2, lines 50-51] and apparently would have nothing to do with improving a chewing gum texture.

However, an unexpected and advantageous effect obtained by the present invention is that encapsulating the chewing gum center by a barrier layer actually provides the possibility of reducing the amount of compression aid within the tablet and obtaining the result that the incorporated natural resin provides an improved and sticky texture to the tablet.

In relation to item (b) identified above, the Examiner stated that:

Regarding claim 6, Cherukuri et al. are silent as to the "improved and sticky" texture of the tablet resulting from the inclusion of the natural resin. However, as the invention of Cherukuri et al. comprises the same ingredients as claimed by Applicants in substantially similar amounts, this improved texture would have been expected to be present in the invention of Cherukuri et al....

Applicant respectfully traverses the Examiner's conclusion, because the Examiner's contention that Cherukuri et al. comprises the same ingredients as claimed by Applicant in similar amounts cannot overcome the fact that the resulting texture would NOT be the same, because according to Applicant's invention, compression aid is located in a barrier layer encapsulating the chewing gum center. This means that even if the ingredients and amounts of ingredients are exactly the same, at least some of the compression aid, which in Cherukuri et al. is part of the chewing gum composition, will in the present invention NOT be part of the chewing gum composition because it is located in the barrier layer instead. Consequently, the improved texture would not on this background have been expected to be present in the invention of Cherukuri et al.

Even though the Examiner's conclusion is hereby already traversed, Applicant also respectfully disagrees with the mere statement that "the invention of Cherukuri et al. comprises the same ingredients as claimed by Applicants". In fact, Cherukuri et al. does not disclose any gum base granules and does not disclose one single example of a gum base or chewing gum composition in which natural resin is forming a part. Only, a listing in general terms is provided, and here it is stated that "the gum base comprises natural or synthetic rubbers or elastomers". Furthermore, it is stated that the gums and elastomers are useful as gum bases [See, e.g., Cherukuri, column 6, lines 14-23], and therefore that the gum bases are suitable without any resins at all.

Consequently, reaching the invention according to amended Claim 1 would indeed be non-obvious to a person of ordinary skill in the art.

Double Patenting Rejections

With respect to the provisional nonstatutory obviousness-type double patenting rejection, Applicant will consider submitting the appropriate terminal disclaimer once allowable matter has been identified in the present case.

For the foregoing reasons, Applicant respectfully submits that all pending claims, namely Claims 1, 3-5, 8-12, 14-19 and 28-32, are patentable over the references of record, and earnestly solicits allowance of the same.

Respectfully submitted,

October 26, 2009

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